



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Election +  
Exps.  
Casper  
6-21-02

IN RE THE APPLICATION OF:

Inventor : Mitchell R. Swartz

Serial no. 09/ 750,765

Filed: 12/28/00

For: **METHOD AND APPARATUS  
TO CONTROL ISOTOPIC FUEL  
LOADED WITHIN A MATERIAL**

This is a continuation of Serial no. 07/ 760,970

Filed: 09/17/1991

PAPER: 10

Group Art Unit: 3641

Examiner: Mr. H. Behrend

**RECEIVED**

JUN 10 2002

**GROUP 3600**

May 14, 2002

**Applicant's Response To  
The Unsigned Communication #9**

**REMARKS**

1. This is Applicant's Response to the Office's Action mailed 4/17/01 (Exhibit "A", attached) which is unsigned and was prepared ~9/14/01.

2. Appellant's submitted and received (Exhibit "B", attached) Motion for Recusal of Mr. Harvey Behrend (Exhibit "C", attached), supported by an Affidavit (Exhibit "D", attached) have both simply been ignored by Mr. Behrend or removed from the file by Mr. Behrend. However, these pleadings were specifically and precisely directed toward his supervisor, and should have

been addressed prior to Mr. Behrend's latest communication ignoring said pleadings. New copies are attached hereto.

3. Applicant hereby responds fully and completely to all matters in said Office Action dated 4/17/01, and complies with the Examiner's requests therein.

4. Examiner Behrend states:

*"Applicant also alleges that the examiner is precluded from making a restriction in the present case due to actions by a different examiner in the parent case 07/760970. The examiner does not agree since each patent application (and its accompanying claims) are treated on their own merits. See particularly MPEP 811.04 which states: "Even though inventions are grouped together in a requirement in a parent application, restriction or election among the inventions may be required in the divisional applications, if proper."*

[Office Action from Examiner Behrend, mailed 4/17/02]

Mr. Behrend is disingenuous. The Applicant asked for reconsideration and gave substantial reasons to support that request. With those reasons brought up by the Applicant, the Examiner has not given a substantive response. The most important reasons involved Mr. Behrend's previous function, and possibly direct, tampering with the record and Mr. Behrend's apparent systematic demands for double-patenting.

## **BACKGROUND**

Attention is now directed to exactly what Examiner Wasil stated in his very careful, and very erudite examination of Serial No. 07/760970, of which the present application is a continuation, and from which other patent applications are being prosecuted.

**"Restriction to one of the following inventions is required under 35 U.S.C. 121:**

**I. Claims 1-12, drawn to a method for controlling nuclear fusion including creating a change in the quantity of fuel, classified in Class 376, subclass 146.**

**II Claims 13-16, drawn to a method including the formation of composite material, classified in Class 428, subclass 548.**

**III. Claims 17-18, drawn to a method of controlling nuclear fusion including two orthogonal electric fields, classified in Class 376, subclass 100.**

**IV. Claims 19-20, drawn to a method for integrating plural fusion reactors, classified in Class 376, subclass 347, (911).**

**V. Claims 21-24, drawn to a method to increase loading by electrochemical means and including electrodepositing, classified in Class 204, subclass 14.1"**

[Communication From Daniel Wasil, Primary Examiner,

SN 07/760970, 6/8/92]

Attention is therefore directed to the fact that Examiner Wasil already divided the present invention into five (5) logical inventions.

- 1) "a method for controlling nuclear fusion including creating a change in the quantity of fuel",
- 2) "a method including the formation of composite material",
- 3) "a method of controlling nuclear fusion including two orthogonal electric fields",
- 4) "a method for integrating plural fusion reactors" and
- 5) "a method to increase loading by electrochemical means and including electrodepositing".

Second, in response to Examiner Wasil's requirement that the applicant elect which invention he wished to continue prosecuting in the original application, Applicant in 1992 elected the "method for controlling nuclear fusion including creating a change in the quantity of fuel" (Exhibit C). That is what the present application is about --a continuation of the original application. This application is directly from Primary Examiner Wasil #5 of his division of the application. Dr. Wasil stated this to be "a method to increase loading by electrochemical means and including electrodepositing".

## LAW

A. Applicant cited Mr. Behrend having ignored the standards of review in light of 37 CFR 1.142. For the second, or third, Mr. Behrend refuses to explain why, given Examiner Wasil's previous restriction, the latest restriction can support separate patents which are independent [37 CFR §1.142, (MPEP §806.04 - §806.04(j))] and [37 CFR §1.142]/or [MPEP §806.05 - §806.05(i)] distinct.

**"If two or more independent and distinct inventions are claimed in a single application, the examiner shall require...his claim shall be restricted"**  
[Requirement for Restriction in the Code of Federal Regulations (37 CFR §1.142), underlined for emphasis]

B. Applicant cited Mr. Behrend having ignored the standards of review in light of MPEP §803.1. For the second, or third, Mr. Behrend refuses to explain why, given Examiner Wasil's previous restriction, the new Examiner's *de novo* and conflicting analysis should be used against the public interest.

**"Since requirements for restriction under Title 35 U.S.C. 121 are discretionary with the Commissioner, it becomes very important that the practice under this section be carefully administered. Notwithstanding the fact that this section of the statute apparently protects the applicant against the dangers that previously might have resulted from compliance with an improper requirement for restriction, it still remains important from the standpoint of the public interest that no requirements be made which might result in the issuance of two patents for the same invention. Therefore, to guard against this possibility, the primary examiner must personally review and sign all final requirements for restriction." [803.01, Review by Primary Examiner]**

C. Applicant cited Mr. Behrend having ignored the standards of review in light of the fact that Examiners "must provide reasons and/or examples to support (his new) conclusions". For the second, or third, Mr. Behrend has simply ignored this.

**"GUIDELINES - Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the requirement in most cases. Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement."**

D. Applicant cited Mr. Behrend having ignored the standards of review in light of MPEP §808. For the second, or third, Mr. Behrend refuses to explain why, given Examiner Wasil's previous restriction, Mr. Behrend is entitled to give his notions without foundation, and without "reasons" including "the reasons for insisting upon restriction".

**"Every requirement to restrict has two aspects: (1) the reasons (as distinguished from the mere statement of conclusion) why the invention as claimed are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween as set forth in the following sections." [MPEP 808, Reasons for Insisting Upon Restriction]**

E. Applicant cited Mr. Behrend having ignored the standards of review in light of MPEP §803. For the second, or third, Mr. Behrend refuses to explain why, given Examiner Wasil's previous restriction, Mr. Behrend can refuse to ignore the already existing record and examine this case on the merits.

**"803 - If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. ...There must be a serious burden on the examiner if restriction is required." [underlined for emphasis]**

F. Applicant cited Mr. Behrend having ignored the standards of review in light of Diamond v. Diehr and *In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967); *In re Chilowsky*, 229 F.2d 457, 462, 108 USPQ 321, 325 (CCPA 1956), and *In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980). For the second, or third, Mr. Behrend refuses to explain why, given Examiner Wasil's previous restriction, Mr. Behrend can ignore already existing Declarations, pleadings, and Exhibits, as he demands to delay and obstruct this, and apparently systematically all, of Applicant's applications in this field. As the Court has found:

**"Respondents' claims must be considered as a whole, it being inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis." [Diamond v. Diehr, 450 U.S. 175 (1981), 450 U.S. 175, No. 79-1112, 3/3/81]**

G. It is wrong for Mr. Behrend to even give the appearance of forcing Applicant into double patenting. Mr. Wasil's 1992 restriction 07/760,970 already created several inventions. The record demonstrates that this has been concluded. The Federal Court has even concluded this. Applicant has also stated reasons why the restriction requirement should be withdrawn or modified with a substantive basis and explanation.

6. Applicant notes that the failure to respond to Applicant's points is unfair. It is consistent with the failure to follow the standards of review, and the failure of the Examiner to comply with the previous Examiner, the ongoing record, and the Federal Court. Applicant requests reconsideration, an examination of the actual record of this case, and a withdrawal of the second "first-restriction" requirement. The Applicant requests that the Office's future response be directed to the actual application, record, and previous response by Examiner Wasil. Applicant hereby preserves the Right of Petition.

==== CONTINUING REMARKS TO EXAMINER ====

5. Examiner Behrend states:

*"The reply filed on 6/18/01 is not fully responsive to the prior Office action because of the following omission(s) or matter(s): The response failed to elect a species from the grouping in section 2 on page 2 of the 6/6/01 Office action."*

[Office Action from Examiner Behrend, mailed 4/17/02]

The Applicant asked for reconsideration and gave substantial reasons to support that request. To those reasons brought up by the Applicant, the Examiner has not given a substantive response.

Nonetheless, to fully comply with the Examiner's requests, and upon close reading of the Examiner's Communications cited above including said page 2 of said 6/6/01 Office action, the Applicant hereby fully clarifies this matter.

Applicant elects species VIII (which Mr. Behrend purports must be a figure, and in this case is "the embodiment of Fig. 18"). The claims readable on said species are claims 1-10, 12-19. Claims 11 and 20, as renumbered after filing, are not readable. Applicant hereby preserves the Right of Petition.

6. Examiner Behrend has requested:

*"The election of species requirement in section 5 on page 3 of the 6/6/01 Office action required applicant to elect a single specie of the number of barrier layers and of the material each barrier layer is made of. On the top of page 12 of the 6/18/01 response, applicants election of "at least one barrier layer", is non-responsive because the election is open ended (applicant must elect one of, one layer, or two layers, etc., (and the material for each layer))."*

[Office Action from Examiner Behrend, mailed 4/17/02]

The Applicant asked for reconsideration and gave substantial reasons to support that request. To those reasons brought up by the Applicant, the Examiner has not given a substantive response. For example, Applicant notes that "part A at the bottom of page 2 of the 6/6/01 Office action refers to an electrode and not a barrier. The Examiners citations "in section 5 on page 3 of the 6/6/01 Office action" cites two different types of barriers, structural barriers and then diffusion barriers. The Applicant asked the Examiner for clarification in Applicant's response, but Mr. Behrend offered no clarification. Instead, he now refers to neither structural barriers nor diffusion barriers, but now cites an electrode ["part A at the bottom of page 2 of the 6/6/01 Office action"]. This is unfair and designed to prejudice the Applicant.

Nonetheless, to fully and completely comply with each and every one of the Examiner's requests --even though Applicant has requested clarification and has not received it-- upon close reading of the Examiner's Communications cited above including said page 3 of said 6/6/01 Office action, the Applicant hereby fully clarifies this matter.

Applicant selects one (1) diffusion barrier, with the material to be gold, as the diffusion barrier. The claims readable on this are claims 1-10, 12-19. Claims 11 and 20, as renumbered after filing, are not readable. Applicant hereby preserves the Right of Petition.

7. Examiner Behrend states:

*"The 6/6/01 Office action had in some instances in defining or reciting the members/species within a particular group, set forth in a parenthetical expression, a reference to a particular portion of the specification or to a claim (e.g. see part A at the bottom of page 2 of the 6/6/01 Office action)."*

*"Applicant in several portions of the 6/18/01 response, stated that applicant has examined the location cited by the examiner, does not understand the relevance, and requests clarification (e.g. see the bottom portion of page 7 of the 6/18/01 response)."*

*The relevance is that the specified portion of the specification or specified claim, describes or gives examples of the item in question."*

[Office Action from Examiner Behrend, mailed 4/17/02]

The Applicant asked for reconsideration and gave substantial reasons to support that request. To those reasons brought up by the Applicant, the Examiner has not given a substantive response. In this case, the Applicant notes that "part A at the bottom of page 2 of the 6/6/01 Office action" refers to an electrode and not a barrier. The Examiners citations "in section 5 on page 3 of the 6/6/01 Office action" cites two different types of barriers, structural barriers and then diffusion barriers. The Applicant asked the Examiner for



clarification in Applicant's response, but there is no clarification offered by Mr. Behrend, who refers now to neither structural barriers nor diffusion barriers, but now cites an electrode ["part A at the bottom of page 2 of the 6/6/01 Office action"].

8. Examiner Behrend states:

*"It is not clear what applicant means by the statement, "there is no "patentable difference" with respect to the above-entitled application" (e.g. see the top portion of page 8 of the 6/8/01 response).*

*In this respect, it is noted that if applicant will state on the record that the indicated species within a particular grouping are not patentably distinct, the election of species requirement for that particular grouping will be withdrawn (see the paragraph bridging pages 4 and 5 of the 6/6/01 Office action) (an example of this would be if applicant (in the response to this Office action) would state that the species listed as A-D in section 3 of the 6/6/01 Office action, are obvious variants of one another, then the election of species requirement in said section 3 of the 6/6/01 Office action would be withdrawn)."*

[Office Action from Examiner Behrend, mailed 4/17/02]

The Applicant asked for reconsideration and gave substantial reasons to support that request. To those reasons brought up by the Applicant, the Examiner has not given a substantive response.

Nonetheless, to fully and completely comply with each and every one of the Examiner's requests --even though Applicant has requested clarification and has not received it-- Applicant elects, as stated previously, "A". The claims readable on this are claims 1-10, 12-19. Claims 11 and 20, as renumbered after filing, are not readable. Applicant hereby preserves the Right of Petition.

9. Examiner Behrend states:

*"Note that for applicants response to be complete, it must include an election of the species set forth in each of sections 2 and 5 of the 6/6/01 Office action. See 37 CFR 1.111."*

[Office Action from Examiner Behrend, mailed 4/17/02]

Nonetheless, to fully and completely comply with each and every one of the Examiner's requests --even though Applicant has requested clarification and has not received it-- Applicant elects for section 2, species "VIII" (which Mr. Behrends purports is "the embodiment of Fig. 18"). The claims readable on said species are claims 1-10, 12-19. Applicant hereby preserves the Right of Petition.

Applicant elects for section 3, species "A". Wherein the cathode is formed of single metal only. The claims readable on said species III (which Applicant elects under protest (infra)) are claims 1-10, 12-19. Applicant hereby preserves the Right of Petition.

Applicant elects for section 4, species of metal, palladium. The claims readable on said species III (which Applicant elects under protest (infra)) are claims 1-10, 12-19. Applicant hereby preserves the Right of Petition.

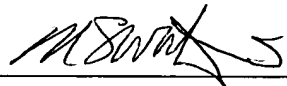
Applicant elects for section 5, one (1) diffusion barrier, with the material to be gold, as the diffusion barrier. The claims readable on this (which Applicant elects under protest (infra)) are claims 1-10, 12-19. Applicant hereby preserves the Right of Petition.

**APPLICANT AGAIN REQUESTS SUGGESTIONS**

10. Applicant requested constructive assistance and suggestions from the Examiner in drafting one or more acceptable claims [pursuant to MPEP 707.07(j)] and in making constructive suggestions [pursuant to MPEP 706.03(d)]. None have been provided again. Applicant again requests constructive assistance and suggestions from the Examiner in drafting one or more acceptable claims [pursuant to MPEP 707.07(j)] and in making constructive suggestions [pursuant to MPEP 706.03(d)].

Applicant has fully and completely replied to each of the Mr. Behrend's demands. Applicant hereby preserves the Right of Petition and notes that the U.S. Supreme Court has ruled that any *pro se* litigant is entitled to less stringent standards [U.S. Rep volume 404, pages 520-521 (72)].

Respectfully,

  
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Mitchell R. Swartz, ScD, MD, EE  
Post Office Box 81135  
Wellesley Hills, Mass. 02481

**Certificate Of Mailing [37 CFR 1.8(a)]**

To Whom it Does Concern:

I hereby certify that this correspondence will be deposited with the United States Postal Service by First Class Mail, postage prepaid, in an envelope addressed to

"The Commissioner of Patents and Trademarks  
Washington, D.C. 20231" on the date below.

Thank you.  
Sincerely,

May 14, 2002

  
M.R. Swartz